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10/750,615	12/30/2003	Daniel F. Justin	13447.41	8943

7590 05/01/2007
DANA L. TANGREN
WORKMAN NYDEGGER
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,615

Applicant(s)

JUSTIN ET AL.

Examiner

Michael B. Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34 and 36-43 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20050209, 20050722 & 20050829.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of invention III, claims 32-43 in the reply filed on 04/11/2007 is acknowledged.

Claim Objections

Claims 38-41 are objected to because of the following informalities: in line 1 of claims 38-40, and in lines 1, 2 and 3 of claim 41 "cutting template" should be --resecting template--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "the bottom surface of the plate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

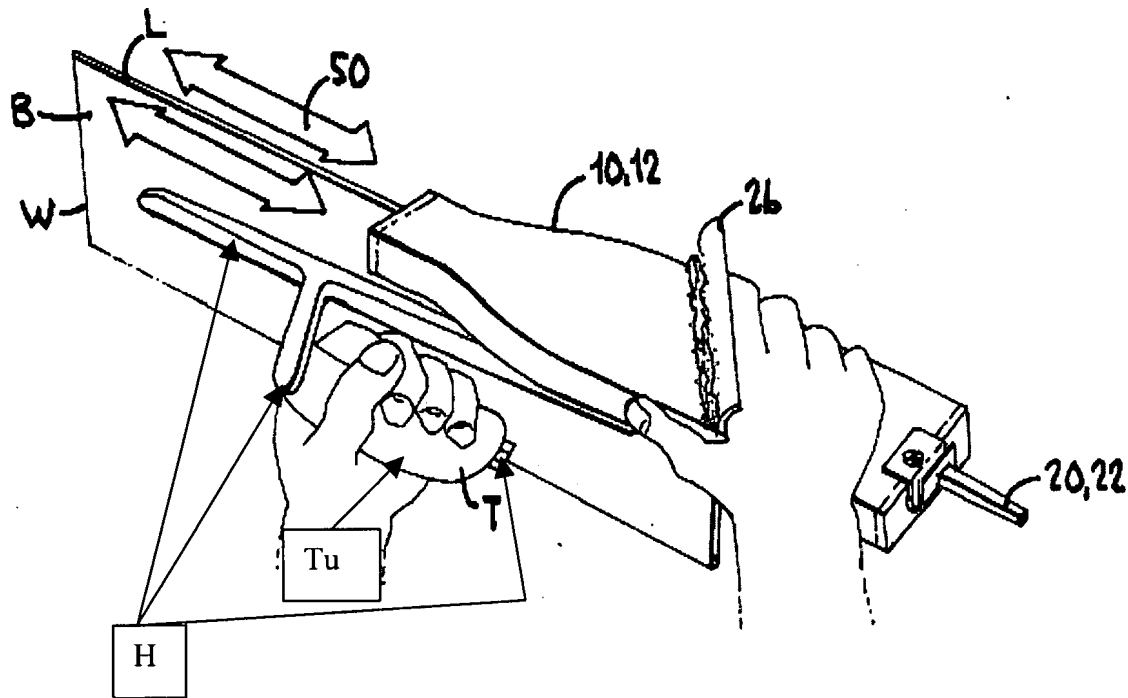
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffschneider et al. (US 5,885,035) with reference to Figs. 2 and marked up Fig. 5 below. Hoffschneider et al. teach a system capable of resecting at least a portion of a lateral or medial facet at the proximal end of a tibia, the system comprising: a rasp body 20 having a bottom surface with a plurality of cutting edges, the rasp body 20 being capable of placement on a lateral or medial facet at a proximal end of a tibia; an elongated retention rod H/T; a rasp guide B slidably mounted on the rasp body 20 such that the at least a portion of the rasp guide B projects from or is accessible through the bottom surface of the rasp body; and the retention rod H/Tu is engaged to the rasp guide B; wherein the retention rod comprises: a tubular set rod Tu; and a hook rod H disposed within the tubular set rod Tu.



Claims 37-40, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Pennig (US 5,346, 496). Pennig teaches a system capable of being used to resect at least a portion of a lateral or medial facet at a proximal end of a tibia, the tibia having a tunnel with a proximal end at a lateral, medial or anterior side of a proximal end of the tibia and a distal end at the lateral or medial facet of the tibia, the system comprising: a first resecting template 5 at least partially bounding a plurality of discrete guide spaces 3, 4 extending through the first resecting template 5, the first resecting template 5 being capable of placement on the lateral or medial facet of the tibia such that guide spaces 3, 4 are aligned with at least a first portion of the lateral or medial facet of the tibia to be resected; a retention rod 1/6 adapted to fit within the tunnel formed on the tibia; wherein the resecting template comprises a plate 5 having a top surface and an opposing bottom surface, the guide spaces 3, 4 extending between

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the top surface and the bottom surface so as to be completely bounded by the plate 5; wherein each of the plurality of guide spaces comprises an elongated open channel extending through the first resecting template 5; wherein the means for removably engaging the retention rod to the first resecting template 5 comprises a tubular set rod 1 and a hook 6 disposed within the tubular set rod 1 (at 8/8').

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennig (US 5,346,496). Pennig as presented in the above 102(b) rejection of claims 37-40, 42 and 43 teaches all of the limitations of the present invention except that two resecting templates are provided. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Pennig with a plurality of resecting templates, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 76 of copending Application No. 10/798,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims are merely functional.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 37 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 81 of copending Application No. 10/798,665. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the differences between the claims are merely functional.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 35 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy

Michael B. Priddy
April 18, 2007


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER